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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,215	09/11/2000	Howard Allan Abrams	004747.P006	5736
26797	7590	06/28/2004	EXAMINER	
SILICON VALLEY PATENT AGENCY, INC. 7394 WILDFLOWER WAY CUPERTINO, CA 95014			COBY, FRANTZ	
			ART UNIT	PAPER NUMBER
			2171	13

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/659,215

Applicant(s)

ABRAMS ET AL. 

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,10,12-14,16-19 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 10, 12-14, 16-19, 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This is in response to Applicant's response to office action filed on April 02, 2004.

**Status of Claims**

Claims 1, 3-7, 10, 12-14, 16-19, 23-26 are pending.

Applicant's arguments filed on the aforementioned date have been fully considered but they are not persuasive. Therefore the rejection of claims 1, 3-7, 10, 12-14, 16-19, 23-26 mailed on October 02, 2003 (paper # 10) remains.

**The rejection follows:**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1, 10, 14 and 23-26 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Dennis Heimbigner "Adapting Publish/Subscribe Middleware to Achieve Gnutella-like Functionality" Technical Report CUOCS-909-00, September 01, 2000, pages 1-16.

As per claims 1, 10, 14 and 23, Dennis Heimbigner discloses the claimed limitations of "receiving a query to a first set of users accessible by a first user via a data

network, the query including information relevant to a request for information and the first set of users being on the data network when the query is sent; and forwarding a response to the query from a second user over the data network, the second user being a member of the first set of users, the response including information responsive to the query, the information accessible in a public portion of a system controlled at least in part by the second user" by providing a simple request-response paradigm for sharing files directly between peer computers. Wherein, users send out request for files; these requests are propagated to all peer nodes in the network, and in response, nodes generate replies back to the query originator indicating that they have the specified file or files (See Dennis Heimbigner Page 1). In summary, Dennis Heimbigner achieved the claimed limitations of claims 1, 10, 14 and 23 by providing a decentralized architecture including a simple request-response paradigm for sharing files directly between peer computers. In particular, Users sent out requests for files; these requests are propagated to all peer nodes in the Dennis Heimbigner's network, and in response, nodes generate replies back to the query originator indicating that they have the specified file or files.

As per claims 24-26, the limitations of these claims have been noted in the rejection of claim 23 above. In addition, Dennis Heimbigner discloses a community sharing public information by allowing a plurality of nodes to be connected and sharing resources across the Internet; wherein when users sent out requests for files; these requests are propagated to all peer nodes in the Dennis Heimbigner's network, and in

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response, nodes generate replies back to the query originator indicating that they have the specified file or files.

Claims 1, 10 and 14 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by "How Napster Worked" Printed pages 1-14. A Napster Timeline is provided for evidence only that Napster began operations allowing people to swap music files since June 01, 1999.

As per claims 1, 10 and 14, Napster discloses the claimed limitations of "receiving a query to a first set of users accessible by a first user via a data network, the query including information relevant to a request for information and the first set of users being on the data network when the query is sent; and forwarding a response to the query from a second user over the data network, the second user being a member of the first set of users, the response including information responsive to the query, the information accessible in a public portion of a system controlled at least in part by the second user" by providing a peer to peer sharing, or P2P which allow users to query for files they want and then access the user's computer b to download the requested files. For instance, when you want to download a song using Napster, you are downloading it from another person's machine, and that person could be your next-door neighbor or someone halfway around the world. (See How Napster Worked Printed page 1).

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Further, the Napster Utility on your computer queries the index Server and Napster builds a list of these systems in the results window (See How Napster Worked, Printed pages 2-3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 12-13, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis Heimbigner "Adapting Publish/Subscribe Middleware to Achieve Gnutella-like Functionality" Technical Report CUOCS-909-00, September 01, 2000, pages 1-16.

As per claims 3, 12 and 16, most of the limitations of this claim have been noted in the rejection of claims 1 and 10, 14, and 23 Applicant's attention is directed to the rejection of claims 1, 10, 14 and 23 above. It is note that Dennis Heimbigner did not specifically detail discloses the claimed feature of "forwarding the query to a second set of users when there is no response received from the first set of users" and "receiving a response form a third user including information responsive to the query from a public portion of a system controller at least in part by the third user; and forwarding the response to the first user" as recited in the instant claims 3, 12 and 16. However,

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Dennis Heimbigner recognizes that, when a query is sent by a user, the query is propagated to all the other users including all other group of users in the Gnutella network until a response to the query is found and then forwarded to the query originator (See Dennis Heimbigner Section 1, pages 1-2). The Applicant should duly note that, by allowing the query to be propagated to all other users in the network is an indication, for the simple reason, to make sure that if one set of users does not have the requested file, a second set of users or a third set of users etc... will have a response to the query. The Applicant should also note that the Gnutella network has suggested forming a Peer-to-Peer working group having three different sets of users. Namely, IBM, Hewlett-Packard and Intel (See Dennis Heimbigner Page 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have improved on the Peer to Peer working group suggestion of Dennis Heimbigner by propagating a query among group of users because that would have provided faster query responses as well as ability for users to sent out requests based on interest of groups or clusters of users.

As per claims 4-5, most of the limitations of these claims have been noted in the rejection of claim 3 above. In addition, Dennis Heimbigner discloses the claimed feature of "adding the third user to the first set of users" by allowing new user to sign or join the Gnutella network. Further Dennis Heimbigner does not show any relation among users. Therefore, Dennis Heimbigner also achieved the claimed feature of "the second set of

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users dynamically formed such that the second set of users has no intersection with the first set of users" (See Dennis Heimbigner Sections 1-2).

As per claim 13, most of the limitations of these claims have been noted in the rejection of claim 12 above. In addition, Dennis Heimbigner discloses the claimed feature of "adding the third user to the first set of users" by allowing new user to sign or join the Gnutella network. Further Dennis Heimbigner does not show any relation among users. Therefore, Dennis Heimbigner also achieved the claimed feature of "the second set of users dynamically formed such that the second set of users has no intersection with the first set of users" (See Dennis Heimbigner Sections 1-2).

As per claim 17, all the limitations of this claim have been noted in the rejection of claims 4-5 and 13 above. It is therefore rejected as set forth above.

Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis Heimbigner "Adapting Publish/Subscribe Middleware to Achieve Gnutella-like Functionality" Technical Report CUOCS-909-00, September 01, 2000, pages 1-16 in view of "How Napster Worked"

As per claim 6, most of the limitations of this claim have been noted in the rejection of claim 5 above.

It is noted, however, Dennis Heimbigner did not specifically detail the claimed feature of "the query includes a list of users known to have had the query sent to each

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user of the list of users" as recited in the instant claim 6. On the other hand, the Napster Utility achieved the aforementioned claimed limitation by allowing Napster to build a list of these systems in the results window (See Printed Page 2). The Applicant should note that, a "Napster Timeline", for evidence, accompanies the applied "Napster" reference only, showing that Napster begins operations, allowing people to swap music file in June 01, 1999.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Peer-to-Peer Architecture of Dennis Heimbigner by incorporating the Napster's teachings. The motivation being, to have provided a central index server that would have informed users where to find the requested files.

As per claim 18, most of the limitations of this claim have been noted in the rejection of claim 17 above.

It is noted, however, Dennis Heimbigner did not specifically detail the claimed feature of "the query includes a list of users known to have had the query sent to each user of the list of users" as recited in the instant claim 18. On the other hand, the Napster Utility achieved the aforementioned claimed limitation by allowing Napster to build a list of these systems in the results window (See Printed Page 2). The Applicant should note that, a "Napster Timeline", for evidence, accompanies the applied "Napster" reference only, showing that Napster began operations, allowing people to swap music file in June 01, 1999.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Peer-to-Peer Architecture of Dennis Heimbigner by incorporating the Napster's teachings. The motivation being, to have provided a central index server that would have informed users where to find a requested file.

9. Claims 7 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis Heimbigner "Adapting Publish/Subscribe Middleware to Achieve Gnutella-like Functionality" Technical Report CUOCS-909-00, September 01, 2000, pages 1-16 in view of Raz U.S. Patent no. 5,701,480.

As per claims 7 and 19, most of the limitations of this claim have been noted in the rejection of claims 4 and 17 respectively. Applicant's attention is directed to the rejection of claims 4 and 17 above.

It is noted however, Dennis Heimbigner (lid not specifically detail the claimed features of "a timestamp indication when the query was originated and further comprising discarding queries received at a time later than the timestamp plus a predetermined length of time" as recited in the instant claims 7 and 19. On the other hand, Raz discloses the aforementioned claimed features by providing a timestamp mechanism for queries wherein queries can be garbage collected at a time later than a timestamp (See Raz Col. 141, lines 55-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the timestamp mechanism of Raz in the network architecture of

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Dennis Heimbigner because that would have allowed queries to provide consistent results.

***Remarks***

The affidavit filed on April 05, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Dennis Heimbigner reference. In particular, the evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Dennis Heimbigner reference. Specifically, the general allegation that the invention was completed prior to the date of the reference is not sufficient. Also, when reviewing the 37 CFR 1.131 affidavit, it has been noted, by the Examiner that the accompanying exhibit does not clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

The Applicant is reminded that the essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. Ex parte Homan, 1905 C.D. 288 (Comm'r Pat. 1905);
- (H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception.

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d). A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

Further, the Applicant failed to respond to the rejection of the Claims 1, 10 and 14 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by "How Napster

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Worked" Printed pages 1-14. A Napster Timeline is provided for evidence only that Napster began operations allowing people to swap music files since June 01, 1999.

### ***Conclusion***


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Maxi-Flex (Monday-Saturday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Frantz Coby  
Primary Examiner  
Art Unit 2171

June 26, 2004